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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Jurgen Bussert

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BAKER BOTTS L.L.P.

PATENT DEPARTMENT

98 SAN JACINTO BLVD., SUITE 1500

AUSTIN, TX 78701-4039

EXAMINER

ARANI, TAGHI T

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/056,905

Applicant(s)

BUSSERT, JURGEN

Examiner

Taghi T. Arani

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Taghi T. Arani  
Primary Examiner  
H2131  
Dated: 4/25/06

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/27/2006.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-16 have been examined and are pending.

### **Continued Examination Under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.1 14, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.1 14, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.1 14. Applicant's submission filed on 3/27/2006 has been entered.

### **Information Disclosure Statement**

2. An initialed and dated copy of Applicant's IDS form 1449, filed 3/27/2006, is attached to the instant Office action.

### **Response to Arguments**

3. Applicant's arguments filed 3/27/2006 has been fully considered but they are not persuasive.

As per claims 1-16, the Applicant has argued (pages 3-4 of the REMARKS) that combination of Redman and Kolouch would not lead to a method or system according to the present independent claims and that nowhere in either Redman or Kolouch can the step of converting an encrypted control program code into HTML or XML format be found to make such a program code accessible for a second development system. Thus, a person skilled in the art would not even be motivated to combine these references.

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The examiner disagrees. In the Office action dated 12/28/2005, the examiner has acknowledged that the primary reference of Redman does not teach converting the encrypted control program into HTML or XML format. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

However, as broadly as it is claimed and by reviewing the specification (paragraphs 0008-0012), the feature “ converting the encrypted data into XML or HTML “ is described as data converted into HTML or XML format, or another format that can be read by standard Internet clients”. The Applicant does not specifically point out how the conversion of encrypted data into XML or HTML makes the claimed conversion distinct from the standard formatting data into XML or HTML and Kolouch’s XML encryption. XML is a well-known data representation standard for digitized information delivery and formatting and the secondary reference of Kolouch discloses converting the encrypted data into XML format (Abstract, col. 5, lines 13-60).

In response to applicant's argument that “ a person skilled in the art would not even be motivated to combine these references”, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) And *In re Jones*, 958 F.2d 347,

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21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teachings of Kolouch's XML encryption scheme expressly provides the motivation to combine the references for an encrypted XML data which provides evidence that other control systems are operating as designed and a significant benefit as business moves to an electronic world (Kolouch, col. 5, lines 1-5).

Therefore, the rejections of claims 1-16 are maintained and are proper.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,978,476 to Redman et al. (hereinafter "Redman") US Patent and further in view of US Patent 6,694,433 to Kolouch.

As per claims 1 and 8, Redman teaches a method and a system for transferring control programs comprising encrypting a control program code in a first development system (Figure 2 and associated text, col. 5, lines 10-19, i.e. generation of encrypted design file, see also col. 10, lines 54-59, the vendor encrypts his design file (control program) using a design file encryption system), transferring the encrypted control program code from the first development system to a second development system (col. 4, lines 41-45, the vendor creates the encrypted design file 103 makes it freely available via download on the World Wide Web), and decrypting the encrypted control program code in the second development system (Figure 4 and associated text, col. 6,

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line 65 67, col. 7, lines 27-29, decryptor 403 within the permission verification system 109 decrypts the authorization code 115 and decodes the encrypted design file using the design decryption key).

While Redman discloses that encrypted design file (encrypted control program code) is freely available on the World Wide Web, Redman does not disclose but Kolouch discloses converting the encrypted control program code by the first development system into HTML- or XML-format and importing the encrypted control program code in HTML- or XML-format via the second development system (Abstract, col. 5, lines 13-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kolouch's XML encryption scheme into the method /system of Redman with a motivation providing evidence that other control systems are operating as designed and a significant benefit as business moves to an electronic world (Kolouch, col. 5, lines 1-5).

**As per claims 2 and 9**, Redman as modified teaches the method and the system according to claims 1 and 8 respectively, further comprising exporting the encrypted control program code in a format that can be read by standard Internet clients via the first development system, and importing a data in the format that can be read by standard Internet clients via the second development system (Redman, col. 4, lines 41-45, the encrypted design file can be freely available via download on the World Wide Web (i.e. Standard Internet clients), Kolouch, col. 5, lines 13-60).

**As per claims 3 and 10**, Redman teaches the method and the system according to claims 1 and 8 respectively, wherein the encryption and decryption of the data is carried out by means of asymmetrical keys (col. 5, lines 32-33):

**As per claim 4**, Redman teaches the method according to claim 1, wherein the encryption of the control program code is carried out following editing of the control program code in the first development system (Figure 2, file header assembler 209 (editor), col. 5, line 63 through col. 6, line 23, accepts information and generate tags A and B to be placed in a file header into the encrypted design file, prior to encrypting the design file (control program)).

**As per claim 5**, Redman teaches the method according to claim 1, wherein the decryption of the encrypted control program code is carried out following editing of the encrypted control program code in the second development system (col. 7, line 55 through col. 8, line 17, design processor 413 performs steps P, Q, R, S, T and U (i.e. editing of the encrypted design file) prior to decrypting the encrypted design file).

**As per claims 6 and 13**, Redman teaches the method and the system according to claims 1 and 8 respectively, wherein only a part of the control program is encrypted (col. 5, line 63-66, i.e. the file header (unencrypted) is appended to encrypted design file (col. 6, lines 27-28)).

**As per claims 7**, Redman teaches a method and for the configuration, project engineering and commissioning of a control system and a drive comprising transferring a control program according to claim 1, comprising compiling the decrypted control program, and processing the compiled control program by means of a microprocessor (Figure 5 and associated text, compiler 503, col. 8, line 64 through col. 9, line 3. performs requested actions for which the user has permission.).

**As per claim 11**, Redman teaches the system according to claim 8, wherein the first development device further comprises an editor for editing the control program code (col. 5, line 63 through col. 6, line 23, i.e. a file header assembler (editor)) and a communication device (col. 4, lines 44-46, Redman discloses that encrypted design file 103 is freely available to the public via download on the World Wide Web (i.e. a communication device)) and a postprocessor (Figure 2 and associated text, i.e. ENCRYPTOR 203 encrypts design files after assembler (editor) accepts information and generate tags A and B to be placed in a file header into the encrypted design file) for encrypting the control program code connected between said editor and communication device.

**As per claim 12**, Redman teaches the system according to claim 8, wherein the second development device further comprises an editor (Figure 4 and associated text, col. 7, line 55 through col. 8, line 17, design processor 413 performs steps P, Q, R, S, T and U (i.e. editing of the encrypted design file) for editing the control program code, a preprocessor for decrypting the control program code (Figure 4, Decryptor 409), and a communication device (col. 4, lines 44-46, Redman discloses that encrypted design file 103 is freely available to the public via download on the World Wide Web (i.e. a communication device)), wherein said editor (design processor 413) is connected between the preprocessor and the communication device (col. 8, lines step w discloses that Decryptor 409 (preprocessor) decrypts the encrypted design file after the design processor (editor) performs editing steps P to U (col. 7, line 65 through col. 8, line 17)).

**As per claim 14**, Redman teaches the system according to claim 8 utilized in an arrangement for the configuration, project engineering and commissioning of a control system and/or a drive (col. 1, lines 18-32, Redman discloses the implementation of his invention in the



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area of Electronic Logic Design where the designers of logic devices program programmable logical devices).

**As per claims 15 and 16**, Redman teaches a method and a system according to claims 6 and 13 respectively, wherein a head part of the control program remains unencrypted (col. 5, line 63-66, i.e. the file header (unencrypted) is appended to encrypted design file (col. 6, lines 27-28)).

### Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Taghi T. Arani, Ph.D.  
Primary Examiner  
Art Unit 2131  
45/25/2006